

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Kenichi NAGAYAMA)	Confirmation No.: 7384
)	
Application No.: 10/586,584)	Group Art Unit: 2826
)	
Filed: February 28, 2008)	Examiner: Tan N. Tran
)	
For: SEMICONDUCTOR DEVICE AND)	
METHOD FOR MANUFACTURING)	
SAME)	

Commissioner for Patents
U.S. Patent and Trademark Office
Alexandria, VA 22314

Sir:

**REQUEST FOR USPTO TO OBTAIN PRIORITY DOCUMENT VIA
PRIORITY DOCUMENT EXCHANGE (PDX) AGREEMENT**

This Request is further to the Amendment previously-filed on April 30, 2009 in the above-identified application, and is in further response to the Office Action dated February 18, 2009 that issued in the above-identified application.

As explained in the Amendment previously-filed on April 30, 2009 in this application, the Office Action dated February 18, 2009 alleges, at page 2 that no certified copy of the priority document has been received in this application. Applicant respectfully traversed this assertion in the Amendment filed on April 30, 2009 because it was Applicant's understanding that the certified copy of the Japanese priority document (JP P2004-012967, filed in Japan on January 21, 2004) had been received in this national stage application from the International Bureau in

accordance with PCT Rule 17.2(a). See the Form PCT/DO/EO/903 (371 Acceptance Notice) form that was mailed on June 23, 2008 which indicates that the priority document has been received. Accordingly, Applicant explained in the Amendment previously-filed on April 30, 2009 in this application it appears that section 12)a)3. should have been checked in section 12 of page 1 of the Office Action (PTOL-326 Form). As a result, acknowledgement of receipt of the certified copy of the Japanese priority document for this application was respectfully requested. To the extent that any of Applicant's understandings are incorrect in these regards, specific clarification was requested to be provided by the Examiner in the next Office Communication.

In response, Applicant's undersigned representative received a telephone call on July 27, 2009 from USPTO Examiner Thomas Dickey of Group Art Unit 2826 explaining that Examiner Tran was unable to locate a copy of this Japanese priority document in the file for the instant application, despite the above-described indication on the Form PCT/DO/EO/903 (371 Acceptance Notice) form that was mailed by the USPTO on June 23, 2008 which indicates that the priority document has been received.

Applicant's undersigned representative placed a follow-up telephone call on July 28, 2009 to bring the following information to Examiner Dickey's attention. In January 2007, the USPTO implemented a procedure for direct electronic priority document exchange with participating foreign intellectual property offices, including the Japan Patent Office (JPO). See Changes to Implement Priority Document Exchange Between Intellectual Property Offices, 72 FR 1664-2 (January 16, 2007), 1315-2 Off. Gaz. Pat. Office (Feb. 13, 2007)(final rule). The USPTO established agreements to obtain and provide priority documents with the European Patent Office (EPO) as of January 16, 2007, and on July 28, 2007, the JPO became the second foreign intellectual property office participating with the USPTO in a priority document

exchange (PDX) agreement. See 37 C.F.R. §§ 1.14(h) and 1.55(d). In accordance with the established PDX procedure, when a U.S. patent application claims foreign priority based on a corresponding Japan Patent Application, as in the present case, the USPTO will automatically attempt to electronically retrieve a copy of the priority document from the JPO. Accordingly, Applicant respectfully submits that the certified copy of the foreign priority document in this case is more appropriately obtained directly from the JPO by the USPTO, rather than from a submission by Applicant. In view of this point, Applicant respectfully requests reconsideration and withdrawal of the Examiner's request that Applicant provide a certified copy of the foreign priority document from which priority is claimed under 35 U.S.C. § 119.

After discussing the foregoing with Examiner Dickey on July 28, 2009, Examiner Dickey recommended that Applicant's undersigned representative file this instant communication as a "separate paper" that requests that the USPTO attempt to obtain this document via the PDX agreement. However, if any of the above-noted understandings are incorrect, the USPTO is respectfully requested to provide clarification in the next Office Communication.

CONCLUSION

In view of the foregoing, Applicant submits that the claims under consideration are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicant's undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

DRINKER BIDDLE & REATH LLP

Dated: July 31, 2009

By:



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